

Application No.:09/681,008  
 Amendment dated: July 25, 2004  
 Reply to Office Action of April 26, 2004

### b.) Remarks

Claims 1, 2, 4-6, 8, 10-20 and 22 are pending in this application. Claim 1 is amended. Claim 21 is canceled, incorporated into claim 1. Claim 1 is also now supported by claims 8 and 15 and the last paragraph of the specification. Claim 23 is new.

Claims 1-2, 4-6 and 8-22 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,532,874 issued to Stein and in view of U.S. Patent No. 6,201,639 issued to Overbeck, and further in view of U.S. Patent No. 6,342,349 to Virtanen. This rejection is respectfully traversed for the following reasons.

The Patent Office has not created a *prima facie* case for obviousness. To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the reference (or references when combined) must teach or suggest all the claim limitations<sup>1</sup>. With regard to some suggestion or motivation to modify the reference or to combine reference teachings, as well as to a reasonable expectation of success, it has been well articulated that a factual inquiry whether to combine references must be based on objective evidence of record<sup>2</sup> and that teachings of references can be combined only if there is some suggestion or incentive to do so<sup>3</sup>.

Turning now to the merits of the Office Action, “Paragraph” 4 of the office action is merely a sentence fragment. Even if the Patent Office had created a *prima facie* case of obviousness, which Applicant in no way concurs, Applicant rebuts.

With respect to paragraph 5 of the office action, Overbeck’s motion of the scanning device is only over a limited arc, and is not a linear motion. See Figs. 2 and 6

<sup>1</sup> MPEP 2142-2143

<sup>2</sup> In re Lee, 277 F.3d 1338, 61 USPQ2d 1430 (Fed. Cir. 2002).

<sup>3</sup> In re Fine, 837 F.2d 1071, 1075, 5 USPQ2d 1596, 1600 (Fed. Cir. 1988).

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and the first line of the Overbeck abstract, and col. 6, lines 11-56, where the motion that the objective lens is capable of is only limited arc oscillation, the "axis of rotation being stationary . . ." (line 56). The invention as presently claimed has a scanning device capable of linear motion, and is further capable of unlimited rotation.

With respect to paragraph 6 of the Office Action, if Stein were combined with Overbeck, one would still not have a replaceable receiving device, nor a carousel insert, nor a laser beam having a non-zero incidence angle, as presently claimed.

With respect to paragraphs 7-8, 13-14 and 22 of the Office Action, Virtanen is not analogous art. The present invention is a microscope which provides the user with a magnified image of a specimen. In contrast, Virtanen provides a user with a chemical analysis of a specimen (see abstract and summary of invention in Virtanen) located in a pit etched in a CD read by a consumer CD player. The word "confocal" in Virtanen merely means having common foci. If a random optical element has a confocal attribute, this, by itself, has no more importance than if an optical element is reflective, or convex, or polarizing. Virtanen does not provide a confocal microscope, nor any kind of a microscope, nor a magnified image of a specimen, despite one of the optical elements possessing a confocal character. A person having ordinary skill in the art would not be motivated to look to Virtanen for guidance in how to design a microscope.

With respect to paragraph 9 of the Office Action, Overbeck's scanning device is incapable of "rotating" in a radial direction, since the radial direction requires linear motion. In Fig. 2, it is the microscope slide that is moving in a radial direction with respect to the axis "A," and not the scanning device.

With respect to paragraph 21 of the Office Action, the Patent Office asserts that Overbeck teaches a non-zero incidence angle at Fig. 5 and col.11, lines 40-47. Applicant respectfully disagrees. Fig. 5 shows an on-axis incidence angle, and col. 11, lines 40-47 has to do with chromatic aberration and is silent with respect to incident angle. It should be noted, however, that the first line of the abstract speaks of on-axis scanning, as does col. 2, lines 3-4, which teach: "The rotary micro lenses can avoid aberration effects by

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operating on-axis . . ." Also, col. 6 lines 50-51 teaches: "about an axis that lies normal to the general plane of the object to be examined . . .". See also col.18, line 55 and claims 1, 21, 26, 27 and 28.

Combining Overbeck and Stein does not yield the invention as presently claimed in amended Claim 1, and Applicant submits that claim 1, and all Claims depending from Claim 1, are not obvious in the light of this combination for the reasons stated above. Note that Office Action paragraphs 10-12 and 15-20 are directed towards claims depending on Claim 1.

Therefore, the rejection should be withdrawn and Claim 1 should be allowed. Claim 2, 4-6, 8 and 10-20 and 22 depend off Claim 1 and should also be allowed.

Applicant believes that the present application is in condition for allowance. A Notice of Allowance is respectfully solicited. The Examiner is strongly encouraged to contact the undersigned and to discuss allowance of the pending Claims.

Respectfully submitted,

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